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JFW**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

1293.1197

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Application Number

09/815,345

Filed

March 23, 2001

First Named Inventor

Byung-in MA et al.

Art Unit

2655

Examiner

Gautam Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒ attorney or agent of record.  
Registration number 41,983☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_  
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Signature

James G. McEwen

Typed or printed name

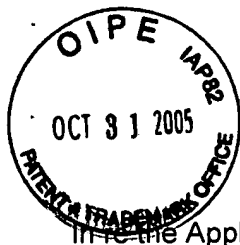
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OCT 31, 2005  
\_\_\_\_\_  
DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.☒ \*Total of 7 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Docket No. 1293.1197**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Byung-in MA et al.

Serial No. 09/815,345

Group Art Unit: 2655

Confirmation No. 4409

Filed: March 23, 2001

Examiner: Gautam Patel

For: APPARATUS FOR GENERATING SEEK DIRECTION DETECTING SIGNAL USING  
TRACK ERROR AND TRACK CROSS SIGNALS FOR AN OPTICAL PICKUP

MAIL STOP AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a request accompanying a Notice of Appeal requesting review of the Final Office Action mailed June 16, 2005, having a shortened period for response set to expire on September 16, 2005. A petition for a two month extension of time is enclosed, thereby extending the response due date to November 16, 2005.

**REQUEST FOR REVIEW OF REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 2-5, the Examiner rejects claims 37-41 under 35 U.S.C. §102 in view of FIGs. 1 and 2 of the instant application (hereinafter "the Other Device"), and specifically asserts that the Other Device shows a sub beam having an optical aberration not disposed in line and incident off of the common track as described in paragraph 0002 of the instant specification. Since paragraph 0002 of the instant specification is included under the heading of the Field of the Invention and is not disclosed as being within the Other Device, it is respectfully requested that the rejection be withdrawn prior to the filing of an Appeal Brief.

By way of review and as set forth in the Response filed September 15, 2005, the Other Device discloses a main beam Bm and two sub beams Bs1, Bs2. The two sub beams Bs1, Bs2 are 1/2 track off of the main beam Bm. (Paragraph 0005, FIG. 1 of the Other Device). However, there is no disclosure or suggestion of an aberration for either of the two sub beams Bs1, Bs2, or of a placement for such an aberration relative to the track and the sub beams Bs1, Bs2. As

such, the Other Device does not disclose or suggest, among other features, that "the sub-beam further comprises an optical aberration not disposed in the line and incident off of the common track" as recited in claim 37.

In order to clarify the rejection, the Examiner states on page 4 of the Office Action that paragraph 0002 of the instant application includes in the Other Device an optical aberration in the sub beam. As a point of clarification, paragraph 0002 does not indicate that the Other Device includes the features of the present invention. Specifically, paragraph 0002 describes that "[t]he invention relates to an apparatus to generate a seek direction detecting signal for an optical pickup to determine the relative position of a center of an optical spot focused on an optical disk with respect to a center of a disk track in a RAM-type optical disk having a land/groove structure, and more particularly, to an apparatus to generate a seek direction detecting signal for an optical pickup using a main beam and a sub-beam having a predetermined aberration in a radial direction."

In contrast, the description of the Other Device begins at paragraph 0003 under the subheading of Description of the Related Art. There is no suggestion in paragraph 0002 or in the paragraphs within the Description of the Related Art that the features described in paragraph 0002 are included in the Other Device shown in FIG. 2 as set forth in the Office Action.

Further, paragraph 0002 is included under a subheading of Field of the Invention, which relates to the field of art of the invention. While the subheading of the Field of the Invention is under the heading of Background of the Invention, this heading and subheading structure does not necessarily include the disclosure in paragraph 0002 as being prior art or included in the Other Device. Instead, the heading and subheading structure is consistent with the recommended arrangement of the specification outlined in MPEP 608.01(a), MPEP 608.01(c), and 37 CFR 1.77. As set forth in MPEP 608.01(c):

The Background of the Invention ordinarily comprises two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.
- (2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated.

It is respectfully submitted that the applicants' adoption of this suggested arrangement further

does not work as an unequivocal admission that paragraph 0002 is within the prior art as defined in 35 U.S.C. §§102 and/or 103. Since the Examiner does not rely on the Other Device as otherwise disclosing a feature of "the sub-beam further comprises an optical aberration not disposed in the line and incident off of the common track" as recited in claim 37 without the inclusion of paragraph 0002, it is respectfully requested that the Examiner's use of features not shown to be in the prior art is clear error sufficient for reconsideration and withdrawal the rejection of claim 37.

For at least similar reasons, it is respectfully submitted that the Other Device does not disclose or suggest, among other features, "a light dividing unit to divide the light beam into a main beam to be formed on a first track of the optical disk and a sub-beam to be formed on the first track of the optical disk, the sub-beam comprising a spot focusing on the first track without being focused on a second track disposed radially apart from the first track and an optical aberration that is focused on at least the second track on the optical disk" as recited in claim 40.

Claims 38, 39 and 41 are deemed patentable due at least to their depending from corresponding claims 37 and 40.

**STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION**

On page 5 of the Office Action, the Examiner states that claims 1-36 and 42 are allowed.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot.

Respectfully submitted,

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